

**Notice of Allowability**

Application No.

10/660,347

Examiner

Celia Chang

Applicant(s)

DUNCIA ET AL.

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to examiner's amendment attached.
2. ☒ The allowed claim(s) is/are 1-7.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.


**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date attached.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

  
Celia Chang  
Primary Examiner  
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### DETAILED ACTION

1. Claims 1-13 are in the case.

2. *Restriction/Election*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, drawn to compounds and composition of formula I, classified in class 546, subclass 210.
- II. Claims 7 and 9, drawn to method of modulating chemokine receptors, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of an end pathology and a single disclosed species of active ingredient for the particular pathology is also required.
- III. Claims 11-13, drawn to method of treating disease, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single disease of claim 11 and a single disclosed species of active ingredient for treating the disease is also required.
- IV. Claim 8, drawn to method of treating asthma, classified in class 514, subclass 326.
- V. Claim 10, drawn to method of treating inflammatory disorders, classified in class 514, subclass various, depending on species election. If this group is elected, a further election of a single inflammatory disorder and a single disclosed species of active ingredient for the disorder is also required.

The inventions are distinct, each from the other because:

Inventions I and II-V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case at least four processes of use have been identified. Further, it is evidenced at least for the method of treating asthma, it can be practiced with another materially different product such as a  $\beta$ 2-adrenergic agonists of CA 141:224161.

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During a telephone conversation with Ms. VanAtten on Jun. 30, 2005 a provisional election was made without traverse to prosecute the invention of group I, claims 1-6. In accordance with MPEP 821.04 and *In re Ochiai*, 71 F. 3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product will occur following a finding that the product claims are allowable. Until, such time, a restriction between product claims and process claims is deemed proper. Applicants have further elected group IV to be fully dependent on the compounds of group I as a rejoinder to the elected compounds and composition.

Claims 1-6, 8 are prosecuted. Claims 7, 9-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

**2. *Examiner's Amendment***

Authorization for this examiner's amendment was given in a telephone interview with Mary VanAtten on June 30, 2005.

Claims 7, 9-13 being drawn to the non-elected invention are canceled without prejudice of applicant's filing of divisional applications.

**3. *Reason for Allowance***

The following is an examiner's statement of reasons for allowance:

The compound claims are drawn to a very limited group of compounds with particular structural limitation explicitly delineated in formula I. These compounds are neither anticipated nor rendered obvious by the art of record. The closest prior art compounds are found in US 6,638,950 (cited on 1449) at column 77. US 6,638,950 disclosed compounds wherein the N of the piperidiny ring must be substituted by a CO or SO<sub>2</sub> linker while the instant claims are drawn to an alkylene with  $\beta$ -hydroxy substitution linker. Compounds in analogous art provided negative teaching since in analogous art, the  $\beta$ -position of the alkylene chain is exclusively alkyl substituted (see US 6,323,334 or US 6,770,650, see PTO-892). No motivation to modify the prior art compounds to the instant claims. Therefore, claims 1-6 and 8 are allowed.

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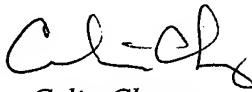
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang  
July 7, 2005

  
Celia Chang  
Primary Examiner  
Art Unit 1625